

Attorney Docket No. P70693US0  
Application No. 10/541,619

Remarks:

Claims 7-16, previously presented, and claims 27-36, newly presented, are pending.

Claims 1-6 and 17-26 are cancelled, without prejudice or disclaimer.

New claims 27-36 correspond to present claims 13-16 7-12, respectively, alternatively written as explained further below, in connection with the rejection under 112, ¶2.

Claims 7-16 were rejected under 35 U.S.C. §112, ¶2, for allegedly being indefinite.

Reconsideration is requested.

According to the rejection (Office Action, page 2):

Claims 7, 10 and 14 recite the limitations, "(measured by a Brookfield rotary viscometer using spindle No. 7, at 2rpm, at 20° C) in low shear rate region (0.43 sec<sup>-1</sup>) and the point C and D being at 20-2000 poises of an apparent viscosity (measured by an apparent viscosity meter according to JIS K2220, at 20° C) in high shear rate region (783 sec<sup>-1</sup>)". It is unclear if the limitations within the parentheses are meant to further limit the claims. For the purpose of this examination these limitations are considered to be optional.

For a number of reasons the rejection is improper; however, notwithstanding the impropriety in finding the claims ambiguous, more importantly it constitutes a clearly erroneous interpretation of the rejected claims.

It is applicant's sole prerogative to define the claims. *In re Pilkington*, 162 USPQ 145, 148 (CCPA 1969). The PTO cannot read into the claims limitations that simply are not there. *In re Donaldson Co. Inc.*, 29 USPQ2d 1845, 1850 (Fed. Cir. 1994). *See Motorola Inc. v. Interdigital Technology Corp.*, 43 USPQ2d 1481, 1490 (Fed. Cir. 1997). However: "All words in a claim must be considered [by the PTO] in judging the patentability of that claim." *In re*

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*Wilson*, 165 USPQ 494, 496 (CCPA 1970) (emphasis added). Moreover, the PTO cannot interpret the claims in a manner that conflicts with the specification. *In re Zletz*, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989).

The word “optional” is erroneously read into the rejected claims by the PTO, which is clearly erroneous. *Donaldson Co. Inc.*, 29 USPQ2d at 1850. *Wilson*, 165 USPQ at 496. Moreover, the PTO interpretation is clearly erroneous because it conflicts with interpretation of the claims in accordance with the specification (*Zletz*, 13 USPQ2d at 1322); that is, the instant specification (page 4, first complete paragraph) excludes apparent viscosities outside the claim recited “low shear rate region ( $0.43 \text{ sec}^{-1}$ ) and . . . high shear rate region ( $783 \text{ sec}^{-1}$ ).”

Notwithstanding the foregoing, newly presented claims 27-36 correspond to claims 13-16 and 7-12, respectively, rewritten without claim limitations being in parentheses.

In view of the foregoing remarks, the rejection of claims 7-16 under §112, ¶2, is overcome. Withdrawal of the rejection is in order.

Claims 7-16 were rejected under 35 U.S.C. §103(a) for allegedly having been obvious over JP 06198152 (Okuda)—citing to text in US6538040 equivalent—and US 4,778,631 (Cobbs) and further evidenced by Polymer Technology. Reconsideration is requested.

First of all, the rejection cannot be maintained because it mistakenly, and impermissibly, relies on combining the teachings of Okuda and Cobbs. Combining the teachings of Okuda and Cobbs (although not the only references combined) is indispensable to the rejection. However,

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combining the teachings of Okuda and Cobbs to reject the claims under §103(a) is impermissible, because Okuda teaches away from Cobbs.

"There is no suggestion to combine ... if a reference teaches away from its combination with another source." *Tec Air, Inc., v. Denso Manufacturing Michigan Inc.*, 52 USPQ2d 1294, 1298 (Fed. Cir. 1999). If the first of two cited references "teach[es] away from [the second reference], then that finding alone can defeat [the alleged] obviousness claim." *Winner Int'l. Royalty Corp. v. Wang*, 53 USPQ2d 1580, 1587 (Fed. Cir. 2000), *cert. denied*, 530 U.S. 1238 (2000).

Okuda discloses use of a piston-pump mixer. The apparatus disclosed by Cobbs (column 3, line 32) is a disk mixer, and the reference teaches away from using a piston-pump mixer for the same purpose (Cobbs, column 2, lines 27-31). Moreover, it is apparent to a person of ordinary skill in the art that a disk mixer is far different in its structure and the suitable material viscosity or the applied pressure from the piston pump used by Okuda (and, as recited in the present claims 7 and 27, as discussed below).

Accordingly, contrary to allegations set forth in the rejection, "There is no suggestion to combine ... [since] reference [Cobbs] teaches away from its combination with another source [Okuda]." *Tec Air, Inc.*, 52 USPQ2d at 1298. Since Cobbs "teach[es] away from [Okuda], then that finding alone can defeat [the alleged] obviousness claim." *Winner Int'l. Royalty Corp.* 53 USPQ2d at 1587.

Secondly, the rejection cannot be maintained because Cobbs teaches away from the

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presently claimed invention. "A reference may be said to teach away when a person of ordinary skill, upon reading the reference...would be led in a direction divergent from the path that was taken by the applicant." *In re Gurley*, 31 USPQ2d 1130, 1131 (Fed. Cir. 1994). Since "a person of ordinary skill, upon reading the [Cobbs] reference...would be led in a direction divergent from the [piston-pump mixer] path that was taken by the applicant," Cobbs is "said to teach away" for purposes of analysis under §103(a). *Gurley*, 31 USPQ2d at 1131. The present claims cannot be rejected for obviousness by relying on Cros, because it is shown that Cros teaches away from the presently claimed invention *In re Geisler*, 116 F.3d 1465, 1471 (Fed. Cir. 1997). *See In re Belle* 991 F.2d 781, 26 USPQ2d 1529, 1552 (Fed. Cir. 1993) ("A disclosure ... does not render obvious a claim to three compounds, particularly when that disclosure indicates a preference leading away from the claimed compounds").

Third, the PTO found the rejected claims non-obvious, under §103(a), over the combined teachings of Okuda and Cobbs (at least implicitly) by the Notice of Panel Decision from Pre-Appeal Brief Review (mailed August 2, 2010), i.e., in view of applicants' Pre-Appeal Brief Request for Review (filed May 21, 2010). As such, Polymer Technology is relied on to allegedly provide what is missing from the combined teachings of Okuda and Cobbs that would render the claims unpatentable under §103(a). With all due respect, the reliance on Polymer Technology is misplaced.

Where the *optimization* of a claim variable was not recognized in the art as effecting the claimed result, the result is unobvious. *In re Antonie*, 195 USPQ 6, 8 (CCPA 1977). That a

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difference with the prior art amounts to an alleged "optimal condition...is not a substitute for some teaching or suggestion supporting an obviousness rejection." *In re Rijckaert*, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). "Reliance on *per se* rules of obviousness is legally incorrect and must cease." *In re Ochiai*, 37 USPQ2d 1127, 1129 (Fed. Cir. 1995). If the prior art fails to disclose a rationale for varying parameters to be result effective, it can not have been obvious to choose the claimed parameter. *Antonie*, 195 USPQ at 8. Differences between the claimed structure and the prior art structure do not amount to "an obvious design choice," when "the different structures...achieve different purposes." *In re Gal*, 25 USPQ2d 1076, 1078 (Fed. Cir. 1992).

Reliance on Polymer Technology is misplaced because (as with Okuda and Cobbs) it fails to recognize the result effected by varying the "apparent viscosity" and "shear rate" parameter recited in the rejected claims, which is of record only in the teachings of invention set forth in subject application. Nothing in any of the cited references, taking references alone or combined with the other cited references, that would have motivated one of ordinary skill in the art to select the "one-pack-type curing paste material having an apparent viscosity [of 50-3000 poises in the region of low shear rate and 20-2000 poises in the region of high shear rate] and shear rate [measured in the region of low shear rate at 0.43 sec<sup>-1</sup> and in the region of high shear rate at 783 sec<sup>-1</sup>]" in accordance with the presently claimed invention. *Antoine*, 195 USPQ at 8.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA

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1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *Wilson*, 165 USPQ at 496 (CCPA 1970). A "ground of rejection is simply inadequate on its face...[when] the cited references do not support each limitation of [the] claim." *In re Thrift*, 63 USPQ2d 2002, 2008 (Fed. Cir. 2002). When conducting an obviousness analysis, "all limitations of a claim must be considered in determining the claimed subject matter as is referred to in 35 U.S.C. 103 and it is error to ignore specific limitations distinguishing over the [prior art] reference." *Ex parte Murphy*, 217 USPQ 479, 481 (PO Bd. App. 1982).

Okuda simply disclose a hotmelt material as a high viscosity polymeric material but do not disclose any viscosity of the material. Cobbs discloses examples of materials having a viscosity of 2,200 cps up to as high as 740,000 cps, i.e., the skilled person is taught to select but the reference neither teaches nor suggests anything about as examples but does not disclose any shear rate thereof. It discloses a viscosity of hotmelt materials in the description from column 6, line 63 to column 7, line 7 and in examples 1 and 2, and also discloses a viscosity of a polyisobutylene sealant in example 4. However, the temperature for measurement of the viscosity disclosed is in a range of 350 to 370°F which corresponds to a range of as high as 177 to 190°C. Viscosity temperature properties of materials are endless variety depending on a kind of resins and the composition thereof. Therefore, the viscosity of the materials disclosed in Cobbs, where no shear rate thereof is known and the temperature for measurement thereof is far different from that of the present invention, should not be obviously within the viscosity range defined by the present invention.

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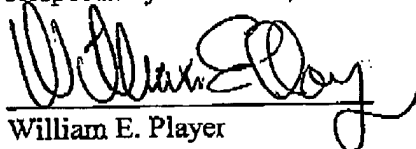
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Lastly, the rejection cannot be maintained because it is based on a clearly erroneous claim interpretation, as explained (above) in connection with the §112, ¶2. "All words in a claim must be considered in judging the patentability of that claim against the prior art." *Wilson*, 165 USPQ at 496 (CCPA 1970). It constituted PTO "error to ignore specific [shear rate] limitations distinguishing over the [prior art] reference," rendering the rejection untenable. *Murphy*, 217 USPQ at 481.

In view of the foregoing remarks, the rejection of claims 7-19 under 35 U.S.C. §103(a) as allegedly obvious over Okuda and Polymer Technology is overcome. Withdrawal of the rejection is in order.

Favorable action is requested.

Respectfully submitted,



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